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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/752,367

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Martijn Jeroen Dekker

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

HUBER, PAUL W

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

07/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/752,367

Applicant(s)

DEKKER, MARTIJN JEROËN

Examiner

Paul Huber

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-14, 16, 18-20, 22 and 24 is/are rejected.
- 7) ☒ Claim(s) 15, 17, 21 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/850,360.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

Art Unit: 2627

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The Information Disclosure Statement filed January 6, 2004 was considered. The references cited therein were listed on the enclosed PTO-892.

Claims 12, 18 and 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 8, 10 and 11 of U.S. Patent No. 6,693,864. Although the conflicting claims are not identical, they are not patentably distinct from each other because: as noted by the Federal Circuit in *Eli Lilly v. Barr*, "[a] patentable distinction does not lie where a later claim is anticipated by an earlier one" (see also *In re Berg* and *In re Goodman* which established that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim).

Claims 12, 18 and 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4 and 7-9 of U.S. Patent No. 6,600,709. Although the conflicting claims are not identical, they are not patentably distinct from each other because: as noted by the Federal Circuit in *Eli Lilly v. Barr*, "[a] patentable distinction does not lie where a later claim is anticipated by an earlier one" (see also *In re Berg* and *In re Goodman* which established that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2627

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-14, 16, 18-20, 22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura et al. (USP-6,280,810).

Regarding claims 12, 18 & 24, Nakamura et al. discloses a method and recording device for producing a recording medium containing an information signal. See figures 5A – 5B. The recording device includes a radiation source for applying a radiation beam to an information layer of a recording medium, means for moving the radiation beam along the information layer, and control means to control the power of the radiation beam. The control means causes a first area of the information layer to assume a first state to form a mark in response to an information signal, e.g., marks before and after 3T in figure 5A. The radiation beam is pulsed including erasing pulses having an erase power level ( $P_e$ ) and a bias power level ( $P_b$ ) between the erase pulses to a second area of the information layer, before and after the mark, to cause the second area of the information layer to assume a second state 3T that is different than the first state. The bias power level ( $P_b$ ) is in a range between zero and the erase power level ( $P_e$ ).

Regarding claims 13 & 19, see col. 1, lines 14-27.

Regarding claims 14 & 20, the range (power level) of the bias power level ( $P_b$ ) is less than a write power level ( $P_w$ ).

Regarding claims 16 & 22, the erase pulses have a duty cycle (ratio  $Y$ ) of  $T_e/T_b$ , where  $T_e$  is the duration of an erase pulse and  $T_b$  is the time between two successive erase pulses. See col. 12, lines 1-4. The duty cycle depends on the recording speed ( $V$ ). See col. 12, lines 10-13.

Claims 12-14, 18-20 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohno et al. (USP-5,109,373).

Regarding claims 12, 18 & 24, Ohno et al. discloses a method and recording device for producing a recording medium containing an information signal. See figures 4(a) – 6. The recording device comprising: a radiation source 5 for applying a radiation beam to an information layer of a recording medium 7; means for moving

Art Unit: 2627

the radiation beam along the information layer; and control means 8, 9 to control the power of the radiation beam. The control means causes a first area of the information layer to assume a first state to form a mark in response to an information signal, e.g., 11T of figure 4(a). The radiation beam is pulsed including erasing pulses having an erase power level ( $P_b$ ) and a bias power level ( $P_r$ ) between the erase pulses to a second area of the information layer, before and after the mark 11T, to cause the second area of the information layer to assume a second state that is different than the first state. See, for example, figure 4(b). The bias power level ( $P_r$ ) is in a range between zero and the erase power level ( $P_b$ ).

Regarding claims 13 & 19, see col. 4, lines 48-51, and col. 6, lines 31-42.

Regarding claims 14 & 20, the range (power level) of the bias power level ( $P_r$ ) is less than a write power level ( $P_p$ ). See, for example, figure 4(b).

Claims 15, 17, 21 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 571-272-7588.



Paul Huber  
Primary Examiner  
Art Unit 2627

pwh  
June 27, 2007